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09/856,112	08/28/2001	Uwe Feuchter	10191/1827	5096

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,112

Applicant(s)

FEUCHTER ET AL.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/14/04 have been fully considered but they are not persuasive.

Applicant argues that **"Yamamoto does not teach or suggest a device that is insertable such that it is forceable from one position into another position, is returned to the one position by an elastic restoring force, is forceable in a releasable and lockable manner into the one position, and is detected in the one position and in the another position by an actuating device"** (Amendment, page 6, 2nd paragraph).

The examiner respectfully traverses applicant's arguments in that the claims are broader than what applicant argues. Based on applicant's clarification of the claim, Yamamoto teach of a device (electronic key (60)) that is insertable as shown in figure 2 {col. 3, lines 43-44}, such that it is forceable/turned from one position (accessories on) into another position (ignition on) {col. 3, lines 60-65}, is returned to the one position by an elastic restoring force {col. 7, lines 30-35}, is forceable in a releasable and lockable manner into the one position {col. 7, lines 10-26}, and is detected in the one position and in the another position by an actuating device (rotary switch 24 or ECU 20) {col. 3, lines 28-35}.

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2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., push detecting switch 98 detects operating knob 40 in two positions (page 6, 3rd paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, applicant claims **"an actuating device for detecting the corresponding external electronic enabling device in the one position and the another position"**.

3. Rejection to the claims are maintained in this Office action.

Specification

4. Applicant is again reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, **the abstract recites "The present invention..." in page 20, line 3.**

Drawings

5. Objection to the drawings under 37 CFR 1.83(a) is withdrawn.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 9-11, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,400,254 (Yamamoto et al).

In claim 9, a driving authorization system for a motor vehicle, the driving authorization system comprising:

an electronically codable recognition device (24) fixed to the vehicle and including a receiving device (40) that forms a receiving region {col. 3, lines 42-55};

a corresponding external electronic enabling device (60) insertable into the recognition device {col. 3, lines 43-44}, and in the receiving region (44) being forceable from one position into another position {col. 3, lines 60-65}, in which an elastic restoring force is applicable for returning the corresponding external electronic enabling device in a direction of the one position, the corresponding external electronic enabling device being forceable in a releasable and lockable manner into the one position in the receiving region {col. 3, lines 42-65};

at least one vehicle-specific device (25, 30, 32) being enabling in response to the corresponding external electronic enabling device and being recognizable by the electronically codable recognition device {col. 4, lines 50-63};

an actuating device (24 or 20) in the receiving region for triggering by the corresponding external electronic enabling device, and for detecting the corresponding

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external electronic enabling device in the one position and the another position {col. 3, lines 28-35}, and for triggering a corresponding ignition-lock function {col. 6, lines 22-35; col. 7, lines 10-26}; and

a separately releasable locking mechanism for locking the corresponding external electronic enabling device in the one position {col. 6, lines 52-67; col. 7, lines 30-35}.

Yamamoto does not disclose expressly **“an elastic restoring force applicable for returning the corresponding external electronic enabling device in a direction of the one position”**. However, the rotary switch of Yamamoto has a PUSH/LOCK position. So that when the operating knob (40) is pushed and then turned right, its position changes to that for turning accessories on (ACC) or ignition on {col. 3, lines 58-65}. Obviously, there is an elastic restoring force in the system of Yamamoto to not allow the operating knob to turn right (LOCK position). And a broad interpretation of the claim would be analogous to the same features of the rotary switch of Yamamoto {col. 3, lines 28-35}. Therefore, it would have been obvious to one of ordinary skill in the art to have “an elastic restoring force applicable for returning the corresponding external electronic enabling device in a direction of the one position” in the system of Yamamoto, as claimed, because the elastic restoring force sets the operating knob in the LOCK position.

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In claim 10, the driving authorization system of claim 9, wherein (please refer to figure 2):

the corresponding ignition-lock function is an ignition-on-function (IG/ON) for the one position; and

the corresponding ignition-lock function is the engine-start-function (START) for the another position. See col. 3, lines 62-65.

In claim 11, the driving authorization system of claim 9, wherein:

the corresponding external electronic enabling device is forceable in a releasable and lockable manner into one other position that is detectable by the actuating device {col. 3, lines 28-35, lines 58-62}; and

the actuating device triggers at least one of an ignition-neutral-function and another corresponding ignition-lock function {col. 3, lines 56-65}.

In claim 13, the driving authorization system of claim 9, wherein the corresponding external electronic enabling device is a smart card insertable through a slit into the receiving region {col. 3, lines 43-55}.

In claim 16, the driving authorization system of claim 11, wherein the actuating device, in one of the one position, the another position and the one other position, triggers a communication between the corresponding external electronic enabling

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device and the electronically codable recognition device {paragraph bridging cols. 4 and 5; col. 5, lines 30-35}.

10. Claims 12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,400,254 (Yamamoto et al) in view of US 4,149,394 (Sornes).

In claim 12, Yamamoto does not disclose expressly "the driving authorization system of claim 9, wherein the receiving region includes an elastic locking pin device for interacting with at least one notch in the corresponding external electronic enabling device for releasably locking the corresponding external electronic enabling device in the one position." Sornes, in the same field of endeavor (key and lock), teach of a key and lock system including an elastic locking pin device, as claimed {Sornes, figures 3-6; col. 2, line 58-col. 3, line 22}. Sornes suggests that said features of a key and lock system is desirable because it provides means to change the combination of the lock to a new key for security reasons and in case the key for the lock is lost {Sornes, col. 1, lines 18-23}. Obviously, these features are desirable in the system of Yamamoto. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a receiving region that includes an elastic locking pin device, as claimed, in the system of Yamamoto, because it provides means to change the combination of the lock to a new key for security reasons and in case the key for the lock is lost, as taught by Sornes.

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In claim 14, the driving authorization system of claim 11, wherein the actuating device includes at least one of one mechanical position sensor and at least one optical position sensor for detecting the corresponding external electronic enabling device in one of the one position, the another position and the one other position {Sornes, figures 3-6; col. 2, line 58-col. 3, line 22}.

In claim 15, the driving authorization system of claim 9, further comprising a spring device for returning the corresponding external electronic enabling device to the one position in response to the pressure no longer being applied, the one other position being reachable by applying pressure to the corresponding external electronic enabling device from the one position until a stop is reached {Sornes, col. 2, line 48-col. 3, line 22}.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,441,022 (Yoder et al) is cited in that it teaches of a driving authorization system for a motor vehicle {see whole document}.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

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William L Bangachon
Examiner
Art Unit 2635

August 23, 2004

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read "Michael Horabik", written over the printed name and title.